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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,081	07/29/2003	Herman Hans Forsten	HT3890 US NA	8471

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EXAMINER	
PIERCE, JEREMY R	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/630,081	FORSTEN ET AL.	
	Examiner	Art Unit	
	Jeremy R. Pierce	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) 29-44 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-28 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1/5/05, 11/13/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-28, drawn to a fabric composite, classified in class 442, subclass 370.

   II. Claims 29-38, drawn to a mattress set, classified in class 5, subclass various.

   III. Claims 39-44, drawn to a process for fire-blocking a mattress, classified in class 252, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the mattress set does not require the presence of cellulosic fibers. The subcombination has separate utility such as an insulation material for buildings.

3. Inventions I and III and Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the claimed product may be used as insulation in building materials.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Andrew Golian on May 3, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3-7, 9-15, and 17-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Murphy et al. (US 2004/0060119).

Murphy et al. disclose a fire barrier fabric layer comprising cellulose fibers and organic fibers (Table 1). The barrier encloses a mattress core (claim 1). A ticking may be placed over top the barrier fabric (paragraph 42). The ticking may be several layers of fabric (paragraph 23) and may include a foam layer (paragraph 22). The barrier fabric layer may weight between 0.25 and 8 osy (paragraph 38) and may be 50/50 Visil/Kevlar (Table 1). Visil is a viscose fiber that contains silicic acid and Kevlar is a para-aramid fiber.

Although Murphy et al. do not explicitly teach the limitation of percent cellulose fiber retained upon heating to a certain temperature, it is reasonable to presume that said limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. viscose fiber containing silicic acid) and in the similar production steps (i.e. blending with fire resistant fiber) used to produce the fire retardant fabric. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed retention percentages would obviously have been provided by the process disclosed by Murphy et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. This reasoning also applies to claim 9 having a similar recitation for the organic fiber.

With regard to claim 3, the cushioning layer may comprise either a layer of fabric or foam material (paragraphs 22 and 23). With regard to claims 4 –6, Murphy et al. teach the total heat of combustion for the mattress is less than 25 MJ (claim 3). Although Murphy et al. do not provide the heat of combustion values in units of MJ/sq. yd., it reasonable to presume the claimed properties are inherent because of the use of similar materials, as set forth above. Alternatively, It would have been obvious to a person having ordinary skill in the art at the time of the invention to lower the heat of combustion of the mattress because Murphy et al. teach altering the design to lower the combustion (paragraph 41). With regard to claim 7, an insulating layer may comprise a batting of fibers (paragraph 37). With regard to claims 10 and 11, Murphy et al. teach using poly(p-phenylene terephthalamide) fiber (paragraph 34). With regard to claim 13, a 50/50 blend of a 4 osy fabric would meet the claimed equation according to Figure 2 of Applicant's specification. With regard to claims 14 and 15, Murphy et al. disclose adding oxygen depriving modacrylic fibers to the fabric (paragraph 34). With regard to claims 18, 19, 22, and 23, the fabric may be used in a panel or border (paragraph 41). With regard to claim 20 and 24, Murphy et al. teach the barrier fabric may be quilted to a ticking layer using fire-retardant thread (paragraph 42).

Claim Rejections - 35 USC § 103

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. in view of Keller et al. (U.S. Patent No. 6,174,584).

Murphy et al. do not disclose a basis weight for the ticking. Keller et al. teach that outer covering layers for mattresses should weigh between 100 and 500 gsm in order to provide comfort (column 2, lines 51-56). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide an outer ticking to the fabric of Murphy et al. within the claimed basis weight in order to provide a mattress that is comfortable for sleep, as taught by Keller et al. With regard to claim 10, Murphy et al. teach the fabric may be used in the border of a mattress (paragraph 41).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. in view of Yagi (U.S. Patent No. 4,509,219).

Murphy et al. disclose polyurethane foams and battings (paragraph 41), but do not disclose a thickness for the cushioning layer. Yagi teaches the cushioning layer of a mattress is 2 cm thick. Because Murphy et al. is silent as to the thickness of the cushion, it would have been necessary, and therefore obvious to a person having ordinary skill in the art at the time of the invention to use a cushion with a thickness of 2 cm, since such a thickness known to be useful in mattresses as taught by Yagi.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy et al. in view of Mater et al. (US 2004/0198125).

Murphy et al. teach using off gassing material, but fail to teach polyvinylchloride fibers. Mater et al. teach that halogenated fibers provide oxygen depleting gases when exposed to flames (paragraph 1). Mater et al. also teach that polyvinylchloride fibers are equivalent to modacrylic fibers for such a purpose (claim 45). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use

polyvinylchloride fibers instead of modacrylic fibers as an off gassing fiber in Murphy et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/630,618 in view of Murphy et al. Although the conflicting claims are not identical because different properties are recited, they are not patentably distinct from each other because both sets of claims are directed to similar structural material comprising mattress components and a fire blocking fabric comprising cellulosic and organic fibers. The claims of the '618 Application lack recitation of a cushioning layer. However, Murphy et al. teach adding cushioning layers to mattresses.

It would have been obvious to a person having ordinary skill in the art at the time of the invention to use additional layers in the claimed product of the '618 Application in order to properly manufacture the material into a usable mattress.

This is a provisional obviousness-type double patenting rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Friday between 9am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

Jeremy R. Pierce
May 5, 2005

ELIZABETH M. COLE
PRIMARY EXAMINER